

ESTTA Tracking number: **ESTTA216783**

Filing date: **06/10/2008**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Notice of Opposition

Notice is hereby given that the following parties oppose registration of the indicated application.

Opposers Information

Name	Corporacion Habanos, S.A.
Granted to Date of previous extension	06/11/2008
Address	Avenida 3ra, # 2006e/20 y 22, Miramar Havana, CUBA

Name	Empresa Cubana del Tabaco, dba Cubatabaco
Granted to Date of previous extension	06/11/2008
Address	O'Reilly No. 104 Havana, CUBA

Attorney information	David B. Goldstein Rabinowitz, Boudin, Standard, Krinsky & Lieberman, P.C. 111 Broadway, Suite 1102 New York, NY 10006-1901 UNITED STATES dgoldstein@rbskl.com Phone: 212-254-1111
----------------------	---

Applicant Information

Application No	77975090	Publication date	02/12/2008
Opposition Filing Date	06/10/2008	Opposition Period Ends	06/11/2008
Applicant	HAVANA JOE'S RESTAURANT CONCEPTS LLC Suite 400 4023 North Armenia Ave. Tampa, FL 33607 UNITED STATES		

Goods/Services Affected by Opposition

Class 034. All goods and services in the class are opposed, namely: Cigars from Cuban seed tobacco

Grounds for Opposition

Deceptiveness	Trademark Act section 2(a)
Priority and likelihood of confusion	Trademark Act section 2(d)
The mark is deceptively misdescriptive	Trademark Act section 2(e)(1)

The mark is primarily geographically deceptively misdescriptive	Trademark Act section 2(e)(3)
<i>Torres v. Cantine Torresella S.r.l.Fraud</i>	808 F.2d 46, 1 USPQ2d 1483 (Fed. Cir. 1986)
Other	Art. 23-28, General Inter-American Convention for Trade Mark and Commercial Protection (false indication of geographic origin)

Marks Cited by Opposer as Basis for Opposition

U.S. Registration No.	2177837	Application Date	08/16/1996
Registration Date	08/04/1998	Foreign Priority Date	NONE
Word Mark	HABANOS UNICOS DESDE 1492		
Design Mark			
Description of Mark	The mark consists of a black rectangle with the design of a tobacco leaf and the wording "HABANOS UNICOS DESDE 1492."		
Goods/Services	Class 034. First use: raw tobacco, cigars, cigarettes, cut tobacco rappee, matches, tobacco, tobacco pipes, pipe-holders, ashtrays, match boxes, cigar cases, and humidors		

U.S. Registration No.	1970911	Application Date	09/22/1994
Registration Date	04/30/1996	Foreign Priority Date	NONE
Word Mark	LA CASA DEL HABANO		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 034. First use: raw tobacco; cigars; cigarettes; cut tobacco; rappee; manufactured tobacco of all kinds; matches; tobacco; smoking pipes; pipe-holders, not of precious metal; ashtrays, not of precious metal; match boxes, cigar cases and humidors, not of precious metal		

U.S. Application No.	77157193	Application Date	04/16/2007
Registration Date	NONE	Foreign Priority Date	04/13/2007
Word Mark	HABANOS		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class A. First use: cigars		

Attachments	75151320#TMSN.gif (1 page)(bytes) 74576950#TMSN.gif (1 page)(bytes) 77157193#TMSN.jpeg (1 page)(bytes) Not. Opp. HAVANA JOES.Final.pdf (14 pages)(60735 bytes)
-------------	--

Certificate of Service

The undersigned hereby certifies that a copy of this paper has been served upon all parties, at their address record by First Class Mail on this date.

Signature	/David B. Goldstein/
Name	David B. Goldstein
Date	06/10/2008

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

In the matter of trademark application
Serial No. 77975090
Filed August 15, 2007
For the mark HAVANA JOE'S
Published in the *Official Gazette* on February 12, 2008

CORPORACION HABANOS, S.A., and EMPRESA)
CUBANA DEL TABACO, d.b.a. CUBATABACO)
)
Opposers,)
)
v.)
)
HAVANA JOE'S RESTAURANT CONCEPTS LLC,)
)
Applicant.)

Opposition No. _____

NOTICE OF OPPOSITION

Opposers CORPORACION HABANOS, S.A. ("Habanos, S.A.") and EMPRESA CUBANA DEL TABACO ("Cubatabaco") (together "Opposers") believe that they will be damaged by registration on the principal register of the mark HAVANA JOE'S, Application Serial No. 77975090, for "cigars from Cuban seed tobacco" (hereinafter "Application"), which was published for opposition on February 12, 2008, and, by and through their undersigned attorneys, hereby oppose the registration of said Application, and aver as follows:

THE PARTIES

1. Applicant Havana Joe's Restaurant Concepts LLC ("Applicant") is a Florida limited liability corporation located in Tampa, Florida.
2. Opposer Habanos, S.A. is a corporation organized under the laws of Cuba, with its principal place of business in Havana, Cuba.

3. Opposer Cubatabaco is a state corporation with independent juridical personality and independent property established by law No. 1191, dated April 25, 1966, of the Republic of Cuba, with its principal place of business in Havana, Cuba.

4. Opposer Habanos, S.A. currently owns, among others, the federal registration of the mark, HABANOS UNICOS DESDE 1492, U.S. Reg. No. 2,177,837, applied for on August 16, 1996, in the United States for cigars and related products in International Class 34. Habanos, S.A. uses this mark, translated as "unique Havana cigars since 1492," throughout the world exclusively for cigars that are of 100% Cuban origin.

5. The mark HABANOS UNICOS DESDE 1492 appears regularly in advertisements for Habanos, S.A.'s 100% Cuban origin cigars in international and United States publications. This mark is used in such advertisements both in Spanish and in English translation as "Habanos Unique since 1492" and "Havanas Unique since 1492."

6. Opposer Habanos, S.A. is engaged, *inter alia*, in the trade, marketing, and advertising of Cuban cigars throughout the world, including in Cuba, and the export of Cuban cigars throughout the world (with the exception of the United States due to the United States trade embargo). Habanos, S.A. emphasizes that its cigars are made in Cuba from 100% Cuban-grown tobacco in their promotion, marketing and advertising, including in advertisements in the United States.

7. Opposer Cubatabaco currently owns, among others, the federal registrations in the United States of the mark LA CASA DEL HABANO, U.S. Reg. No. 1,970,911, applied for on September 22, 1994, translated as "the house of the Cuban cigar," for cigars and related products in International Class 34, and for LA CASA DEL HABANO, U.S. Registration No. 2,212,119, applied for on August 16, 1996, as a service mark in International Class 35 for "retail store

services featuring tobacco and smokers' accessories" and in International Class 42 for "social club services, bar services, and restaurant services."

8. Opposer Cubatabaco's LA CASA DEL HABANO Marks regularly appear in advertisements in the United States in connection with cigars that are of 100% Cuban origin.

9. Opposer Cubatabaco currently owns the application in the USPTO for the certification mark HABANOS, Application Serial No. 77157193, in IC A for "cigars," filed April 16, 2007. The mark certifies "that the product bearing the certification mark has the exclusive character of pure Cuban cigars or cigars produced in Cuba," meaning the entire national territory of the Republic of Cuba. The USPTO has suggested that the certification statement be reformulated as certifying "that the cigars have their geographical origin in Cuban and are made from Cuban grown tobacco."

10. The term "HABANA," the Spanish (and French) word for HAVANA, is an appellation of origin (also known as a denomination or indication of geographical origin) for Cuban-origin tobacco and tobacco products registered by Opposer Cubatabaco in 1967 in accordance with the 1958 Lisbon Agreement for the Protection of Appellations of Origin and their International Registration, as revised and amended.

11. The term "HABANOS" is the appellation of origin for cigars originating in the entire national territory of the Republic of Cuba, and was registered by Opposer Cubatabaco in 1967 pursuant to the Lisbon Agreement. Under Opposer Cubatabaco's authority, Opposer Habanos, S.A. uses the "Habanos" geographical denomination of origin on all packages of its 100% Cuban origin cigars.

THE APPLICATION PROCEEDINGS

12. On August 15, 2007, Applicant filed an intent-to-use application in the PTO under Section 1(b) of the Lanham Act, 15 U.S.C. § 1051(b), to register the word mark HAVANA JOE'S in International Class 34 for "cigars from Cuban seed tobacco," and for other goods and services in IC 29 and 43, which application was assigned Serial No. 77256091.

13. On September 12, 2007, the PTO Examiner issued an Office Action stating, "applicant must insert a disclaimer of 'Havana' in the application The word 'Havana' is geographically descriptive of cigars that have their origin in Cuba."

14. Applicant's cigars *do not* "have their origin in Cuba."

15. On September 17, 2007, applicant made a request to divide the application, with Class 34 to become the child application. On October 15, 2007, the PTO assigned Serial No. 77975090 to the Class 34 application.

16. On October 15, the PTO Examiner issued an Office Action directed to Serial No. 77975090, repeating that "applicant must insert a disclaimer of 'Havana' in the application The word 'Havana' is geographically descriptive of cigars that have their origin in Cuba."

17. In neither Office Action, or otherwise, did the Examiner request that Applicant indicate where its cigars originate or whether they originated in Cuba.

18. Applicant filed its Response to the October 15 Office Action on November 16, 2007, disclaiming the word "Havana." Applicant did not disclose to the PTO that in fact its cigars *do not* "have their origin in Cuba."

19. Upon information and belief, Applicant made the disclaimer proposed by the Examiner for the specific purpose of obtaining the applied-for registration, although it knew at the time it made the disclaimer that its cigars do not "have their origins in Cuba."

20. On November 19, 2007, Applicant advised the PTO that “Joe’s” does not identify a particular living individual.

21. Following Applicant’s Responses, Applicant’s applied for mark was published for opposition on February 12, 2008.

22. On March 11, 2008, the Board granted Opposers’ timely filed requests for an extension of time until June 11, 2008, to file an opposition to the Application.

23. Applicant has made no claim of use of the mark, or use of the mark in commerce.

24. Applicant’s mark is, *inter alia*, primarily geographically deceptively misdescriptive, deceptive and deceptively misdescriptive of the identified goods, and further Applicant’s mark is confusingly similar to Opposers’ marks for the same goods.

**THE MEANING OF THE WORD "HAVANA" IN CONNECTION WITH CIGARS AND
THE RENOWN OF HAVANA CIGARS**

25. The word "Havana" primarily refers to the largest city and the capital of Cuba.

26. The primary significance of the mark, HAVANA JOE’S, is a generally known geographic location – Havana, Cuba.

27. The addition of the generic word “JOE’S” does not alter the mark’s primary geographic significance.

28. In addition to denoting the city of Havana, Cuba, “Havana” is used, recognized, and understood throughout the world, including in the United States, by both cigar consumers and within the cigar industry, to denote Havana’s most famous export – cigars that are of 100% Cuban origin, made exclusively from tobacco grown in Cuba and manufactured in Cuba, primarily in or near the city and province of Havana, Cuba.

29. Likewise, the Spanish word “Habano” (and its plural, “Habanos”) is recognized

among cigar consumers and in the cigar industry throughout the world and in the United States to denote cigars that are of 100% Cuban origin.

30. Numerous English language dictionaries and encyclopedias, including those published in the United States, define the word "Havana" to mean a cigar made in Cuba and/or from Cuban tobacco, in addition to denoting the largest and capital city of Cuba.

31. Spanish language dictionaries define "Habano" as relating to, or from, "La Habana" (Spanish for Havana, Cuba), or by extension the island of Cuba, or as a cigar made in Cuba from Cuban tobacco.

32. The leading English-language cigar books, including in book titles, consumer guides, and cigar magazines sold in the United States, and news and feature stories appearing in general circulation magazines, newspapers, and other publications directed to the general public in the U.S use the terms "Habano(s)" and "Havana(s)" to denote a 100% Cuban-origin cigar.

33. "Habana" (Havana) was the term historically used internationally, including in the United States, to identify cigars made in Cuba, and derived from the name of the port from which the cigars were shipped. The term "Habanos" began to be used in Spanish speaking countries at the beginning of the 20th century to denote all Cuban cigars.

34. For decades prior to Applicant's August 15, 2007 Application, the term "Havana" has been used to mean Cuban-origin cigars.

35. United States and international publications directed to the cigar-consuming public and to the trade, including the United States cigar-consuming public and trade, refer to "Havanas" or "Habanos," that is, 100% Cuban-origin cigars, as a different type of cigar from those cigars that are not of Cuban origin.

36. Cuba is internationally recognized, including in the United States, as the most

renowned country in the world for the growth of tobacco for cigars, and for the production and manufacture of cigars, including cigars of the highest quality, and Havana is internationally recognized, including in the United States, as the city and province most renowned for the manufacture and export of the highest quality cigars.

37. No other country is as renowned as Cuba for cigars, and no geographic location is as renowned for cigars as Havana, Cuba.

38. Cuban-origin cigars are desired by cigar smokers throughout the world, including in the United States, because of their Cuban origin.

39. Consumers in the United States and elsewhere in the world associate cigars with Cuba and particularly with Havana, Cuba. This association is one of the strongest goods/place associations of any consumer product with a particular geographic region in the world.

40. The applied-for mark denotes, is, and will be understood by United States consumers as denoting, that cigars bearing that mark are manufactured in Cuba, or are made from tobacco grown in Cuba and manufactured elsewhere.

41. Applicant's goods do not come from Havana, Cuba or elsewhere in Cuba, and are not "Havanas," that is, cigars from Cuba, nor do Applicant's goods otherwise "have their origins in Cuba."

42. Applicant, a Florida corporation, has no lawful means of obtaining or selling Cuban-origin cigars or Cuban-origin tobacco, nor any lawful means of obtaining or selling cigars or other tobacco products that are made anywhere in the world if they are made or derived in whole or in part of any article which is the growth, produce or manufacture of Cuba. Without limitation, this is so because the United States' Cuban Assets Control Regulations, including specifically 31 C.F.R. § 515.201, 515.204, prohibit any such activity.

43. The cigar-consuming public is likely to believe that the place identified by the applied-for mark – Havana, Cuba – describes Applicant’s goods, and their geographic origin, or the geographic origin of the good’s ingredients, when neither the goods nor the ingredients in fact come from Havana or Cuba.

44. Consumers’ mistaken belief that Applicant’s cigars come from Havana or Cuba, or are comprised in whole or in part of tobacco grown in Cuba, would be a material factor in such consumers’ purchasing decision.

45. By use of the word “Havana,” the applied-for mark misdescribes a quality, characteristic, or feature of the goods, *i.e.*, Cuban cigars (or cigars made from tobacco from Cuba), because the goods are not cigars from Cuba, or made from Cuban tobacco.

46. By use of the word “Havana,” which is widely used and understood in the United States to refer to cigars from Cuba, cigar consumers in the United States are likely to believe this misrepresentation of the goods.

APPLICANT’S MEANINGLESS CLAIM THAT ITS GOODS ARE
MADE FROM “CUBAN SEED TOBACCO”

47. Upon information and belief, Applicant represented to the USPTO that its cigars are made “from Cuban seed tobacco” solely to avoid having the USPTO refuse registration on the ground that the use of “Havana” is, *inter alia*, primarily geographically deceptively misdescriptive, although Applicant knew that its goods do not come from Havana or Cuba, do not have their origin in Cuba, and have no connection or association with Havana or Cuba, or with Opposers.

48. When used in the United States to refer to tobacco grown outside of Cuba, “Cuban seed tobacco” is merely a name given to a type of tobacco that is grown outside of Cuba

from seeds that do not themselves come from Cuba, but are claimed, without any means of verification, to be distant descendants of seeds of tobacco plants grown in Cuba many generations ago.

49. Upon information and belief, the type of non-Cuban tobacco that Applicant refers to as “Cuban seed tobacco” either: 1) is a very distant descendant from plants or seeds that were taken from Cuba sometime between 45 and almost 100 years ago, but not more recently than that; *or* 2) is not even a distant descendant from seeds or plants that were taken from Cuba many decades ago, but is merely a type of tobacco, grown outside of Cuba, and generically referred to as “Cuban seed tobacco”; *or* 3) is not the type of tobacco generically referred to as “Cuban seed,” but Applicant may have made such material misrepresentation to the USPTO solely to obtain registration of its applied-for mark through such material misrepresentation.

50. It is not possible to verify whether Applicant’s cigars are, or will be, made from tobacco grown from seeds that are descendants of tobacco seeds that came from Cuba.

51. The identification of the goods as “from Cuban seed tobacco” does not, and cannot, change the primarily geographically deceptively misdescriptive, deceptive, and deceptively misdescriptive nature of Applicant’s mark.

52. Because the term “Cuban seed tobacco” in the identification of goods cannot support the registration of a mark using the word “Havana” in connection with cigars made from non-Cuban tobacco, the use of that term cannot overcome the above statutory bars to registration.

53. Cigars allegedly made from tobacco grown from seeds that are descendants of seeds that came from Cuba are different from cigars made from Cuban-origin tobacco in terms of quality, characteristics, taste and aroma.

54. Upon information and belief, the USPTO would not have published the mark for

opposition had it known that neither “Cuban seed tobacco,” nor the seeds generating the plants that yield the tobacco, come from Havana, Cuba, or anywhere else in Cuba, nor do they have any connection or association with Cuba, Havana, or Cuban-origin cigars, other than the unverifiable possibility of a distant genetic descent.

INJURY TO OPPOSERS

55. Opposers believe that they will be damaged by the registration of the applied-for mark upon the Principal Register, including by Applicant’s use of that mark on cigars of non-Cuban origin, which will damage the reputation that Havana cigars, that is, genuine Cuban-origin cigars, have in the United States. Such registration and use will also deceive consumers into believing that Cuban cigars, or cigars made from Cuban tobacco, are presently available for purchase in the United States.

56. Opposers’ success in marketing 100% Cuban-origin cigars to U.S. consumers as soon as U.S. law permits, including through use of the registered marks HABANOS UNICOS DESDE 1492 & DESIGN and LA CASA DEL HABANO; the applied-for certification mark HABANOS; and “Habanos” as a geographic indication, will be damaged and diminished if Applicant is permitted to register a mark including the term “Habanos”, which deceptively suggests that Applicant’s cigars and other tobacco products are of Cuban origin.

57. Opposers’ current ability to use the above-identified registered trademarks and “Habanos” as a geographic indication and certification mark in advertisements it currently places in the United States in connection with 100% Cuban-origin cigars will be damaged if Applicant is permitted to register the applied-for mark.

58. Applicant’s mark, when used on or in connection with Applicant’s cigars, is likely to cause confusion, or to cause mistake, or to deceive, with respect to Opposer’s registered marks

HABANOS UNICOS DESDE 1492 & DESIGN and LA CASA DEL HABANO, and the applied-for certification mark HABANOS.

FIRST GROUND FOR OPPOSITION

59. Opposers repeat and reallege each and every allegation set forth in paragraphs 1 through 58 of this Notice of Opposition as if fully set forth herein.

60. The applied-for mark, as used on or in connection with Applicant's identified goods, is deceptive and primarily geographically deceptively misdescriptive within the meaning of Section 2(a), (e)(3) of the Lanham Act, 15 U.S.C. § 1052(a), (e)(3), for lack of the requisite nexus with Havana, Cuba or Cuba, and, therefore, registration of the mark must be refused.

SECOND GROUND FOR OPPOSITION

61. Opposers repeat and reallege each and every allegation set forth in paragraphs 1 through 58 of this Notice of Opposition as if fully set forth herein.

62. The applied-for mark, as used on or in connection with Applicant's identified goods, is deceptive and deceptively misdescriptive within the meaning of Section 2(a), (e)(1) of the Lanham Act, 15 U.S.C. § 1052(a), (e)(1), and, therefore, registration of the mark must be refused.

THIRD GROUND FOR OPPOSITION

63. Opposers repeat and reallege each and every allegation set forth in paragraphs 1 through 58 of this Notice of Opposition as if fully set forth herein.

64. Applicant's mark so resembles Opposers' registered marks in IC 34 for the identical goods (cigars) – HABANOS UNICOS DESDE 1492 & DESIGN, Reg. No. 2,177,837, and LA CASA DEL HABANO, Reg. Nos. 1,970,911 – and Cubatabaco's applied for certification mark – HABANOS, Serial No. 77157193, in IC A, filed prior to Applicant's

Application – and used by Opposers in the United States in advertising, as to be likely, when used on or in connection with Applicant’s goods, to cause confusion, or to cause mistake, or to deceive, within the meaning of Section 2(d) of the Lanham Act, 15 U.S.C. § 1052(d), and, therefore, registration of the mark must be refused.

FOURTH GROUND FOR OPPOSITION

65. Opposers hereby incorporate by reference paragraphs 1 through 58 of this Notice of Opposition as if fully set forth herein.

66. “Havana” is an indication of geographical origin or source within the meaning of Articles 23-28 of the General Inter-American Convention for Trade Mark and Commercial Protection, 46 Stat. 2907 (“IAC”), to which both Cuba and the United States are parties, and which treaty is in force between the United States and Cuba.

67. “Havana” does not correspond to the place in which Applicant’s identified goods are, will be, or lawfully could be, fabricated, manufactured, produced or harvested.

68. “Havana” has not through constant, general and reputable use in commerce come to form the name or designation itself of Applicant’s identified goods.

69. To the consuming public, the quality and reputation of cigars depend on the place of production or origin.

70. Articles 23-28 of the IAC prohibit Applicant’s use and registration in the United States of the term “Havana” in connection with non-Cuban origin cigars.

71. Under the aforesaid provisions of the IAC and also pursuant to Section 44(b), (h) of the Lanham Act, 15 U.S.C. § 1126(b), (h), registration of the mark must be refused.

FIFTH GROUND FOR OPPOSITION

72. Opposers repeat and reallege each and every allegation set forth in paragraphs 1

through 58 of this Notice of Opposition as if fully set forth herein.

73. Applicant failed to disclose a material fact to the PTO when it disclaimed “Havana” in response to the Examiner’s statement that “Havana” must be disclaimed because “The word ‘Havana’ is geographically descriptive of cigars that have their origin in Cuba.”

74. When Applicant made its disclaimer, it knew that its cigars did not “have their origin in Cuba,” and it further was aware that the Examiner mistakenly believed that Applicant’s cigars did “have their origin in Cuba.”

75. Applicant made the disclaimer and the material omission with the specific intent of having the PTO rely on the disclaimer in order to obtain registration of the mark.

76. Upon information and belief, but for Applicant’s aforesaid material omission, the PTO would have refused registration of the mark.

77. Because of Applicant’s aforesaid material omission to the PTO, registration of the mark must be refused.

WHEREFORE, Opposers Corporacion Habanos, S.A. and Empresa Cubana del Tabaco pray that registration of the mark in Application Serial No. 77975090 be refused, and that this Opposition be sustained in favor of the Opposers.

Dated: June 10, 2008

Respectfully submitted,

By: /David B. Goldstein/
DAVID B. GOLDSTEIN
RABINOWITZ, BOUDIN, STANDARD,
KRINSKY & LIEBERMAN, P.C.
111 Broadway – Suite 1102
New York, New York 10006-1901
212-254-1111
dgoldstein@rbskl.com
*Attorneys for Opposers Corporacion Habanos, S.A.
and Empresa Cubana del Tabaco*

CERTIFICATE OF ELECTRONIC FILING

I hereby certify that this Notice of Opposition to the registration of the mark in Application Serial No. 77975090 is being filed electronically today, June 10, 2008, on the Electronic System for Trademark Trials and Appeals for the United States Patent Office.

/David B. Goldstein/
David B. Goldstein

CERTIFICATE OF SERVICE

The undersigned certifies that a true and correct copy of the foregoing Notice of Opposition was emailed to Applicant's attorney and correspondent, and was served on Applicant by mailing, postage prepaid, said copy on June 10, 2008 via U.S. Certified Mail, return receipt requested, to the address of record and to the attorney and correspondent listed for Application No. 77975090:

Havana Joe's Restaurant Concepts LLC
4023 North Armenia Ave.
Suite 400
Tampa, FL 33607

Ruth E. Freeburg
Larson & Larson, PA
11199 69th St. North
Largo, FL 33773
larsonb@tampabay.rr.com

/David B. Goldstein/
DAVID B. GOLDSTEIN